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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,762	10/07/1999	RAVI ANANT RAVINDRANATH	003239.P048	3818

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EXAMINER

LEE, TIMOTHY L

ART UNIT	PAPER NUMBER
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2697

DATE MAILED: 10/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/414,762

Applicant(s)

RAVINDRANATH ET AL.

Examiner

Timothy Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27,33-41 and 48-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-27,33-41 and 48-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 21-27, 33-41, and 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rainis et al. (US 6,310,873).
3. Regarding claims 21, 25, 33, 35, 36, and 39, Rainis et al. discloses a system that provides telephonic communication over the Internet and PSTN. Fig. 1 discloses a system where a client (endpoint) contacts a directory server (terminal gateway) when it would like to place a call. The directory server is then responsible for identifying telephony servers that might be willing to handle the call. See also Fig. 2, and col. 4, line 51-col. 5, line 49. Each telephony server handles calls for a specific calling area, and by comparing the receiving party's phone number, the directory server identifies the telephony servers that would be willing to accept the call. The telephone server acts to translate the speech packets sent by the client so that the signal can be sent over standard telephone lines. See col. 7, lines 5-14. Essentially, the servers act as gateways that perform the translation between Internet compressed voice packets and conventional analog telephone signals (gateway adapted to convert IP packets into analog signals and to forward the analog signals via a dedicated communication link between the gateway and the endpoint). See col. 4, lines 37-41. After a server is chosen, the server instructs the telephony hardware to begin the process of calling out to the specified PSTN number. Rainis

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et al. also discloses that the hardware architecture of the terminal devices can include a computer, telephone set, or other similar communication devices (endpoint being one of an IP telephone and a telephone coupled to a terminal gateway). See col. 11, lines 12-23. The user is then notified if the phone is ringing, busy, or when the receiving party picks up (registering a first line of the endpoint with a first communications server; establishing a first telephone call on the first line of the endpoint to a second endpoint via the first communications server). See also col. 6, line 54-col. 7, line 4. Rainis et al. does not expressly disclose registering a second line of the endpoint with a second communications server and establishing a second telephone call on the second line of the endpoint to a third endpoint via the second communications server, but it would have been obvious to a person of ordinary skill in the art at the time of the invention to register a second line with a second server and to establish a second telephone call. One of ordinary skill in the art would have been motivated to do this because Rainis et al. mentions that another embodiment of the invention provides an Internet telephony system that provides as a gateway into a variety of information sources and value added service like call forwarding, call waiting, teleconferencing, and multi-party calling. See col. 17, lines 22-37. In multi-party calling, the user would most likely attempt to make another call while the current call is in session, hence a *multi-party* call. The process of making another call would follow the procedure already explained above, which includes picking a telephony server and placing the call. If a different server is chosen, then the second call will be completed by registering a second line of the endpoint with a second communications server. Also, Rainis et al. mentions that multicasting is possible, which allows one user to send speech packets to several receiving parties for conferencing. If those parties are in different locales where the different servers are to

be used in order to optimize the cost of the conference call, then a third endpoint will have been reached by a second server in order to complete the multicasting call. See col. 7, lines 5-14.

4. Regarding claim 25 more specifically, in order to keep a list of telephony servers it might contact and to identify telephony servers that might be willing to handle the call, the directory server must inherently contain a memory and a processor. See col. 5, lines 24-38. The directory server also receives its instructions to begin the process of finding a telephony server from the client.

5. Regarding claims 36 and 37 more specifically, it is inherent that the directory server would include computer readable program code in order to perform the functions of updating the registration table (list of telephony servers), and to transmit registration messages to the servers from the endpoints.

6. Regarding claims 22 and 40, in order to make a multi-party call, this implies that the first telephone call is not disconnected, or it would just be the same as ending the first call and starting the call initiating process over again.

7. Regarding claim 23, if a multi-party call can include a second server and a third endpoint, then it can certainly extend to a fourth endpoint via a third communications server.

8. Regarding claims 24 and 41, Rainis et al. discloses that a "call" occurs when two or more parties communicate or exchange information using telephony equipment. When the handset is removed from the cradle, this is called an off-hook condition, which tells the central office exchange that someone wants to make a call. The central office returns a dial tone to the calling phone to let the caller know that the exchange is ready to accept a telephone number. The telephone set sends the telephone number by dial pulses or by audio tones. A ringing signal is

sent to the called phone to alert the called party that a call is waiting. When the called party removes the handset in response to a ring, the loop to that phone is completed by its closed switchbook. See col. 1, lines 10-51.

9. Regarding claim 26, if the line connecting the client to the directory services is part of the endpoint, then the directory services must contain part of the client because the line also connects to directory services.

10. Regarding claim 27, it is entirely possible that the second and third endpoints could be the same endpoint. Rainis et al. discloses that the system architecture allows telephony servers to provide access to overlapping service areas, providing opportunities for competition between telephony servers. Therefore, it is possible to connect two lines to the same endpoint through two different servers. See col. 11, lines 23-30.

11. Regarding claim 34, Rainis et al. does not expressly disclose mapping the first and second lines to keys on the endpoint, but it would have been obvious to map lines to keys. One would have been motivated to do this because mapping the lines to keys provides a way for toggling between the two lines.

12. Regarding claim 38, the computer code certainly could be contained at the IP endpoint, which in the case of Rainis et al. is a telephone enabled computer. Rainis et al. discloses that sometimes it is desirable to have one CPU acting as both directory and database server. See col. 11, lines 45-47.

13. Regarding claims 49 and 50, Rainis et al. does disclose an Internet telephony system, so inherently, the terminal gateway must communicate to the server through an IP address of some sort, whether it be the first call or the second call.

14. Regarding claims 51 and 52, as mentioned previously, Rainis et al. discloses that the hardware at the endpoint can include a telephone set. See col. 11, lines 12-22.

Response to Arguments

15. Applicant's arguments filed July 28, 2003 have been fully considered but they are not persuasive. In response to applicant's argument that Rainis et al. does not disclose an endpoint that is either an IP telephone set or a telephone coupled to a terminal gateway, the Examiner respectfully disagrees. As mentioned in the rejection above, Rainis et al. clearly discloses that the hardware architecture of the terminal devices can include a computer, telephone set, or other similar devices. See col. 11, lines 12-23.

16. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is clear that Rainis et al. considers the possibility that the invention could handle multi-party calling or multicasting. It is inherent in a 3-way call or multi-party call that multiple connections must be made. In Rainis et al., if the other parties of the multi-party call are located in different locales where they would require different servers to service the call, then it is implied by Rainis et al. that two different servers will be used to service those two additional endpoints. Thus, Rainis et al. does suggest that it could provide such additional services.

17. In response to applicant's argument that Rainis et al. does not disclose where the gateway can convert between IP packets to analog signal, the Examiner respectfully disagrees. As mentioned in the rejection, Rainis et al. does clearly mention that the server, or gateway, translates Internet compressed voice packets into analog signal to be transported along the standard telephone lines. Hence, Rainis et al. does teach such functionality.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy Lee whose telephone number is (703)305-7349. The examiner can normally be reached on M-F, 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (703)305-4744. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.

TLL



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